

REMARKS

I. General

Claims 1-21 are pending in the Application. Claims 1-21 are rejected as follows:

- Claims 7, 10, and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.
- Claims 11, 12, 15, 16, 18, and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,173,274 to Ryan, Jr. (hereinafter “*Ryan*”).
- Claims 1, 2, 5, and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,041,569 to Freeman et al. (hereinafter “*Freeman*”) in view of U.S. Patent 5,612,888 to Chang et al. (hereinafter “*Chang*”).
- Claim 3, 4, 9, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Freeman* in view of *Chang* in further view of *Ryan*.
- Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Freeman* in view of *Chang* in further view of Official Notice.
- Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of *Chang*.
- Claims 13 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of Official Notice.
- Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of U.S. Patent 6,173,274 to Manduley (hereinafter “*Manduley*”).
- Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of U.S. Patent 5,684,706 to Harman et al. (hereinafter “*Harman*”).

II. 35 U.S.C. § 112 Rejections

Claims 7, 10, and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses the rejections of record.

Claims 7 and 20 stand rejected because the Office Action states that the term “high speed” is a relative term which renders the claim indefinite. Office Action, page 2. Specifically, the Office Action states that the specification does not provide a standard for ascertaining the requisite degree. Office Action, page 2. However, the specification states “[t]he present invention is directed to a system and method that uses Information-Based Indicia (IBI) printed by high-speed printers that operate faster than traditional postage meters” Paragraph [0009]. Furthermore, as high-speed letter printing is well known in the art (*see* the present Application’s background), one of ordinary skill in the would be reasonably apprised of the scope of the invention. As such, Applicant respectfully asserts claims 7 and 20 are definite and particularly point out and distinctly claim the subject matter which Applicant regards as the invention and therefore should be allowed.

Claim 10 stands rejected because the limitation “additional information” has insufficient antecedent basis. Office Action, page 2. Accordingly, claim 10 has been amended to cure this typographical error. Specifically, claim 10 has been amended to recite “the other information.” Now that claim 10 has proper antecedent basis for the limitation, Applicant requests the rejection of record be withdrawn. Further, Applicant asserts this amendment does not narrow the scope of the claim.

III. 35 U.S.C. § 102(b) Rejections

Independent claims 11 and 19 and dependent claims 12, 15, 16, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Ryan*. However, it is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. § 2131. Applicant respectfully asserts that the rejections do not satisfy this requirement, as detailed below.

Claims 11 and 19 are amended to recite limitations from claims 13 and 21 respectively as well as to clarify that the calculation of postage is for individual mail pieces.

Because the limitations from claims 13 and 21 were previously presented in the Application, the amendments present no new matter.

Independent claim 11 recites “calculating a postage value for each individual mail piece based upon the number of pages included for each said individual mail piece” and independent claim 19 recites “means for calculating a postage value for each individual mail piece based upon the number of documents included in each said individual mail piece” (emphasis added). The Office Action cites *Ryan*, column 7, lines 12-14, as teaching calculating a postage value for each mail piece. Office Action, page 2. However, *Ryan* merely teaches the postage value may vary and does not appear to disclose the calculation of postage for each individual mail piece. Col. 7, lines 12-13. Moreover, *Ryan* does not appear to teach any means for calculating postage and does not teach basing postage value on the number of pages included in the mail piece. As such, *Ryan* does not teach at least these limitations of claims 11 and 19 and therefore fails to anticipate claims 11 and 19.

Accordingly, Applicant respectfully asserts the 35 U.S.C. § 102(b) rejections of record is improper and requests the rejections be withdrawn. Furthermore, dependent claims 12, 15, 16, and 18 depend from claim 1, thereby inheriting the limitations therein. As such, at least for the reasons indicated above, dependent claims 12, 15, 16, and 18 are patentable over the 35 U.S.C. § 102(b) rejections of record. Therefore, Applicant requests the rejections be withdrawn and claims 11, 12, 15, 16, 18, and 19 be allowed.

IV. 35 U.S.C. § 103 Rejections

Independent claim 1 and dependent claims 2-10, 13, 14, 17, 20, and 21 stand rejected under 35 U.S.C. § 103 as being obvious. However, in an obviousness rejection, “[u]nder § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 15 - 17 (1966). With regard to the claims rejected under 35 U.S.C. § 103 in the current Application, the Office Action does not show that claims are obvious under the framework set out in *Graham*. Among other things, the differences between the applied art and the claims set the claims apart from the applied art. See *United States v. Adams* 383 U.S. 39, 48 (holding that the Government erred in concluding that wet batteries are old in the art because, among other

things, “the fact that the Adams battery is water-activated sets his device apart from the prior art.”) The rejected claims are considered below.

A. Independent claim 1 and dependent claims 2 and 5-7

Independent claim 1 and dependent claims 2 and 5-7 stand rejected as being unpatentable over *Freeman* in view of *Chang*. However, the cited combination fails to make the claims obvious. Furthermore, claim 1 has been amended herein. As the amendment is supported by paragraph [0013] of the specification, the amendment presents no new matter. Thus, Applicant requests the amendment be entered.

Claim 1 recites “calculating the postage value due for each individual mail piece based upon the number of pages included for each said individual mail piece” (emphasis added). The Office Action cites *Freeman*, column 6, lines 49-54, as teaching postage calculation. Office Action, page 4. However, *Freeman* merely teaches a postage meter is mounted on the base unit and does not appear to disclose the meter calculates the postage for each individual mail piece. *Freeman*, col. 6, lines 49-54. Moreover, *Freeman* seems to fail to teach any means for the meter to calculate postage and does not teach basing postage value on the number of pages included in the mail piece. Furthermore, the Office Action does not rely on *Chang* as teaching calculating the postage value. As such, the cited art does not teach “calculating the postage value due for each individual mail piece based upon the number of pages included for each said individual mail piece” (emphasis added).

Moreover, the combination of *Freeman* in view of *Chang* improper. M.P.E.P. § 2141.02 directs that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” Additionally, “[i]t is improper to combine references where the references teach away from their combination,” M.P.E.P. § 2145.

Chang teaches away from modifying a single document path system as taught by *Freeman*. *Chang*’s method was apparently developed specifically for a multiple document path mailing system because “the use of a single document path is a time consuming process.” Col. 1, lines 18-19. Furthermore, *Chang* states that “methods for control of a mailing system with a single document path ... have certain inadequacies which limit the use

of know control methods with a mailing system having multiple document paths.” *Chang*, col. 1, lines 21-24. As such, *Chang* teaches away from the suggested combination.

Furthermore, *Freeman* teaches away from the modifications of *Chang*; therefore, the suggested combination is improper. Specifically, *Freeman* discloses a mailing system with a single document path (*see* figures 1-4 and 9-14) and states that an object of the invention is to provide a mailing machine which “is relatively simply in design and construction” Col. 5, lines 25-30. Further, *Freeman* states that drawbacks of other mailing systems include “mechanical complexity which entails a relatively high level of manufacturing and maintenance cost” and “physical size and weight.” *Freeman* states that these drawbacks have “been a problem and the source of numerous customer complaints, particularly in professional offices where space it at a premium, since these machines tend to be rather large.” *Freeman*, Col. 1, lines 36-46. *Chang* teaches a mailing system having multiple document paths. *Chang*, Abstract, lines 1-2. As modifying *Freeman* according to *Chang* would add multiple document paths to *Freeman*’s system, the modification would add to the mechanical complexity and physical size and weight of the system. As *Freeman*’s goal is to provide a simple design and construction to alleviate these problems, *Freeman* teaches away for the combination of *Freeman* and *Chang*.

Therefore, the cited portions of the suggested combination fails to teach each and every limitation of claim 1, and the suggested combination is improper. As such, the claim is patentable over the obviousness rejection of record. and Applicant requests the rejection of record be withdrawn and the claim be allowed. Furthermore, dependent claims 2 and 5-7 depend from claim 1 thereby inheriting all the limitations therein. Accordingly, dependent claims 2 and 5-7 are patentable over the rejections of record at least due to the reasons outlined above regarding claim 1. Applicant request that rejections of dependent claims 2 and 5-7 be withdrawn and the claims be allowed.

B. Dependent claims 3, 4, 9, and 10

Dependent claims 3, 4, 9, and 10 stand rejected as unpatentable over *Freeman* in view of *Chang* in further view of *Ryan*. Office Action, page 6. However, the cited combination fails to teach each and every limitation of the claims. Dependent claims 3, 4, 9, and 10 depend from independent claim 1, thereby inheriting all the limitations therein. As such,

dependent claims 3, 4, 9, and 10 are patentable over the rejections of record at least due to their dependence from claim 1. Furthermore, *Ryan* is not relied on as curing the deficiencies detailed above regarding claim 1. Thus, the suggested combination fails to teach each and every limitation of dependent claims 3, 4, 9, and 10.

Moreover, M.P.E.P. § 2141.02 directs that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." Additionally, "[i]t is improper to combine references where the references teach away from their combination," M.P.E.P. § 2145. As *Chang* teaches away from the modifications of *Ryan*, the suggested combination is improper.

Specifically, *Chang* states that "[i]t is an object of the invention to provide an improved method for generating a mailpiece in a high speed mailing system without printing codes on each mailpiece." *Chang*, col. 1, lines 58-60. However, *Ryan* teaches a production mail system wherein "[t]he document includes a control code printed thereon." *Ryan*, Abstract. As such, *Chang* teaches away from the suggested *Chang-Ryan* combination as *Ryan*'s method requires the very code *Chang* does not wish to print. Thus, because the suggested combination is improper, Applicant requests the 35 U.S.C. § 103 rejection of record against dependent claims 3, 4, 9, and 10 be withdrawn.

C. Dependent claim 8

Dependent claim 8 stands rejected as unpatentable over *Freeman* in view of *Chang* in further view of Official Notice. Office Action, page 7. However, the cited combination fails to teach each and every limitation of the claim. Dependent claim 8 depends from independent claim 1, thereby inheriting all the limitations therein. As such, dependent claim 8 is patentable over the rejection of record at least due to its dependence from claim 1. Furthermore, Official Notice is not relied on as curing the deficiencies detailed above regarding claim 1. Thus, the suggested combination fails to teach each and every limitation of dependent claim 8, and Applicant respectfully requests the rejection of record be withdrawn.

D. Dependent claim 17

Dependent claim 17 stands rejected as being unpatentable over *Ryan* in view of *Chang*. However, as explained above regarding claims 3, 4, 9, and 10, *Chang* specifically teaches away from the combination of *Ryan* and *Chang* and is therefore improper. As such, Applicant requests the rejection based on this improper combination be removed.

Furthermore, claim 17 depends from independent claim 11 thereby inheriting all the limitations therein. As such, at least for the reasons detailed above regarding claim 11, *Ryan* fails to teach each limitation of claim 17. As the Office Action does not rely on *Chang* to cure the deficiencies detailed above, the cited combination fails to teach each limitation of claim 17. Office Action, page 8. Therefore, because the cited combination is improper and fails to teach each limitation of claim 17, Applicant requests the rejection of record be withdrawn and the claim be allowed.

E. Dependent claims 13 and 20

Dependent claims 13 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Ryan* in view of Official Notice. However, claims 13 and 20 depend from independent claims 11 and 19, respectively, thereby inheriting all the limitations therein. As explained above, *Ryan* fails to teach every limitation of claims 11 and 19. Thus, *Ryan* likewise fails to teach each limitation of claims 13 and 20. Further, because the Office Action does not rely on Official Notice to cure the deficiencies detailed above, the cited combination does not teach each limitation of claims 13 and 20. Therefore, Applicant respectfully requests the rejections of claims 13 and 20 be withdrawn and the claims be allowed.

F. Dependent claim 14

Dependent claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over *Ryan* in view of *Manduley*. However, claim 14 depends from independent claim 11, thereby inheriting all the limitations therein. As explained above, *Ryan* fails to teach every limitation of claim 11. Thus, *Ryan* likewise fails to teach each limitation of claim 14. Further, because the Office Action does not rely on *Manduley* to cure the deficiencies details above, the cited

combination does not teach each limitation of claim 14. Therefore, Applicant respectfully requests the rejection of claim 14 be withdrawn and the claim be allowed.

G. Dependent claim 21

Dependent claim 21 stands rejected under 35 U.S.C. § 103 as being unpatentable over *Ryan* in view of *Harman*. However, claim 21 depends from independent claim 19 thereby inheriting all the limitations therein. As explained above, *Ryan* fails to teach every limitation of claim 19. As such, *Ryan* likewise fails to teach each limitation of claim 21. Further, because the Office Action does not rely on *Harman* to cure the deficiencies details above, the cited combination does not teach each limitation of claim 21. Therefore, Applicant respectfully requests the rejection of claim 21 be withdrawn and the claim be allowed.

CONCLUSION

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P019US/10303184 from which the undersigned is authorized to draw.

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Respectfully submitted,

By 

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